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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,863	07/31/2003	Ronald D. House	112226	9069
27074	7590	05/23/2007		
OLIFF & BERRIDGE, PLC. P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER MCLEAN, NEIL R	
			ART UNIT	PAPER NUMBER
			2609	
			NOTIFICATION DATE	DELIVERY MODE
			05/23/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction27074@oliff.com
jarmstrong@oliff.com

Office Action Summary

Application No.

10/630,863

Applicant(s)

HOUSE ET AL.

Examiner

Neil R. McLean

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/31/2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 -4 are rejected under 35 U.S.C. 102(e) as being anticipated by Nihei (US 7,098,942).

Nihei discloses a method of transferring data from a portable digital storage media to a sheet media, comprising:

Regarding Claim 1:

reading data (Column 3, lines 31-33) from the portable digital storage media (Column 3, lines 41-44, lines 49-50, 3, 4 and 5 in Figure 1, and 20 in Figure 2), into a digital image forming device (See Figures 1 and 2);

writing the data from the digital image forming device into the sheet media

(Column 3, lines 63-66 and 9/10 in Figures 1 and 2); and

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charging a transaction fee (Column 3, lines 56-60, 8 in Figures 1 and 2, and Step 40 in Figure 4).

Regarding Claim 2:

The method of claim 1, wherein the sheet media is paper (Column 3, line 66 – Column 4, line 2).

Regarding Claim 3:

The method of claim 1, further comprising:
establishing a communication link between the portable digital storage media and the digital image forming device (Column 4, lines 19-21 and 30 in Figure 3).

Regarding Claim 4:

The method of claim 1, further comprising:
determining a transaction type, wherein the portable digital storage media (Column 5, lines 1-7) and the sheet media (Column 5, lines 38-41) are identified according to the determined transaction type (Steps 44/45 in Figure 4).

3. Claims 5-9, 11-12, 14 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Frey et al. (US 6,369,908)

Frey et al. discloses a method of purchasing a portable digital storage media from a digital image forming device, comprising:

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Regarding Claim 5:

selecting a portable digital storage media type (Column 3, lines 3-6);

selecting a portable digital storage media amount (Column 3, lines 3-6);

charging a transaction fee (Column 3, lines 19-21 and Column 6, lines 9-11));

and

dispensing the portable digital storage media (Step 238 in Figure 5).

Regarding Claim 6:

The method of claim 5, wherein the portable digital storage media comprises one or more of CD-ROM, DVD-ROM and CD-RW (Column 3, lines 3-6).

Regarding Claim 7:

The method of claim 5, further comprising:

transferring a computer file from the digital image forming device to the portable digital storage media before the step of dispensing the portable digital storage media (Column 5, lines 25-28 and 238 in Figure 5).

Regarding Claim 8:

A system for purchasing a portable digital storage media from a digital image forming device, the system comprising:

a payment interface (16 in Figures 1 and 2);

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a media distribution device for dispensing the portable digital storage media (Step 238 in Figure 5); and

a user input device for selecting one or more of a portable digital storage media type and a portable digital storage media amount (Column 3, lines 3-6);.

Regarding Claim 9:

The system of claim 8, wherein the portable digital storage media comprises one or more of CD-ROM, DVD-ROM and CD-RW (Column 3, lines 3-6).

Regarding Claim 11:

The system of claim 8, wherein the media distribution device is a digital image forming device (Step 238 in Figure 5), and the portable digital storage media is one or more of CD-ROM, DVD-ROM and CD-RW (Column 3, lines 3-6).

Regarding Claim 12:

A system for transferring a computer file from a portable digital storage media, the system comprising:

a media distribution device for distributing a storage media (Step 238 in Figure 5);

a portable digital storage media read/write interface for coupling the portable digital storage media to the media distribution device (Column 5, lines 25-28 and 238 in Figure 5); and

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a payment interface for accepting payment for a transaction in which the computer file is transferred from the portable digital storage media to the storage media (16 in Figures 1 and 2);.

Regarding Claim 14:

The system of claim 12, wherein the portable digital storage media is one or more of CD-ROM, DVD-ROM and CD-RW and the media distribution device is a digital image forming device (Column 5, lines 21-23).

Regarding Claim 15:

The system of claim 12, further comprising:

a portable electronic device interface, wherein the portable electronic device interface is in communication with the portable digital storage media and wherein the portable digital storage media is controlled by a portable electronic device (Column 5, lines 25-28 and 238 in Figure 5).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frey et al. as applied to claims 8 and above, and further in view of Nihei.

- a. Frey discloses all of the subject matter as described in claims 8 and 12 above;
- b. Except for specifically teaching the method of wherein the digital forming and media distribution device is a digital photocopier.
- c. However, Nihei, in the same field of endeavor, as disclosed in claims 1-7 above, teaches an image capture system which is capable of reading image data that has been recorded on a portable recording medium brought by a user and of printing the image represented by the read image data (Column 3, lines 63-66).
- d. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the digital photocopier of Frey et al. with the image capture system as taught by Nihei.
- e. The motivation to do so would be to help consumers who have shown a strong desire for selecting personal images for printing. However, consumers also exhibit an aversion to uploading posting personal data on the web, even with the use of passwords and other methods of keeping the data secure, and thus are reluctant to use these internet services. Additionally, consumers prefer to receive a tangible manifestation of their data, which can be obtained at an interactive kiosk.

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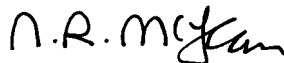
Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fredlund et al. discloses a method for facilitating orders for image services.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. McLean whose telephone number is 571.270.1679. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Liu Shuwang can be reached on 571.272.3036. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Neil R. McLean
05/16/2007



SHUWANG LIU
SUPERVISORY PATENT EXAMINER